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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,873	06/08/2007	Holger Listle	10191/4418	3733
26646 7590 10/26/2011 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER CHEN, SHELLEY				
ART UNIT		PAPER NUMBER		
3661				
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10/26/2011		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,873

Applicant(s)

LISTLE, HOLGER

Examiner

SHELLEY CHEN

Art Unit

3661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 October 2011 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendments/Arguments

1. Applicant's arguments filed 12 October 2011 have been fully considered but are not persuasive. Arguments are addressed in the rejections below.
2. Applicant argues on page 6 that the secondary reference Person fails to disclose enabling the useful data for an area defined by the user as recited in claim 7, because Person discloses instead restricting the display area to the area defined by the user.

This argument is not found persuasive. Firstly, Person clearly discloses that the useful data (map features such as roads, landmarks, etc) is displayed for the defined area (fig 4, col 3: 44-51, col 7: 16- col 8: 12, claim 10, etc). Displaying the useful data is one way of enabling the useful data, as required by the claim.

Secondly, Person does not disclose restricting the display area to the defined area anywhere in his disclosure, as suggested by the Applicant. Only the map features such as roads and landmarks (not the entire map display) are restricted to the defined area. The Applicant may be misinterpreting claim 10 and similar passages stating that the radius is displayed (meaning that a circular shape representing the radius boundary is overlaid on the map) to mean that all data outside the radius is blocked from display. The Applicant's interpretation of Person is incorrect.

Thirdly, the rejection does not rely on Person to teach enabling the useful data for an area (although Person clearly teaches it), because the limitation is already

disclosed by the primary reference Barkowski (see rejection below). Person clearly discloses that the area is defined by defining a center point and a radius of a circular region, which is the only limitation from claim 7 not disclosed by Barkowski.

3. Applicant argues on pages 6-7 that the intended operation of Barkowski is to use an access authorization code to enable a fixed geographical block or multiple blocks, and therefore the modification asserted by the Examiner would “fundamentally change the principle of operation of the device in Barkowski and/or render the device unsuitable for its original purpose, thereby negating the obviousness conclusion”.

This argument is not found persuasive. The fundamental principle of operation of Barkowski is not the use of an access authorization code to enable a fixed geographical block or multiple blocks, as argued by the Applicant. The fundamental principle of operation of Barkowski is directed to the management of navigation data in a navigation system (P1). According to Barkowski's invention, the user defines a region of map data that he wishes to enable (P31), and transmits his defined region (along with other data) to a remote server. In response, the remote server transmits an access authorization code to the vehicle navigation system to enable the defined region of map data.

Thus Barkowski could easily be modified by Person as suggested by the Examiner without changing the fundamental principle of operation of Barkowski. For example, Barkowski could be modified so that the user defines a region using a center point and radius rather than indicating one or more desired countries, cities, or states. The defined region is then transmitted (along with other data) to a remote server. In

response, the remote server transmits an access authorization code to the vehicle navigation system to enable the user-selected region, as in Barkowski's original invention. The selected center point and radius could be encoded into the access code or transmitted in addition to the access code. Barkowski's invention would otherwise operate as before.

4. Applicant argues on pages 6-7 that the secondary reference Person fails to disclose granting of a use authorization for the area defined by the user by defining the center point and the radius of the circular region as recited in claim 10, because Person discloses instead restricting the display area to the area defined by the user.

This argument is not found persuasive. Firstly, the rejection does not rely on Person to teach the granting of a use authorization, because the limitation is already disclosed by Barkowski (see rejection below). Person clearly discloses that the area is defined by defining a center point and a radius of a circular region, which is the only limitation from claim 10 not disclosed by Barkowski.

Secondly, Person does not disclose restricting the display area to the defined area anywhere in his disclosure, as suggested by the Applicant. Only the map features such as roads and landmarks (not the entire map display) are restricted to the defined area. The Applicant may be misinterpreting claim 10 and similar passages stating that the radius is displayed (meaning that a circular shape representing the radius boundary is overlaid on the map) to mean that all data outside the radius is blocked from display. The Applicant's interpretation of Person is incorrect.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 7 and 10, and 12-13 rejected** under 35 U.S.C. 103(a) as being unpatentable over **Barkowski et al.** (DE 10155485, see machine translation) in view of **Person** (U.S. Patent # 5,067,081).

Regarding claim 7, Barkowski (figures 1-2, etc) discloses a method for operating a vehicle navigation system by enabling navigation data (see title) which is stored on a data carrier (DE doc: P14, or machine translation: page 3 paragraph 3 etc), and enabling the useful data for an area definable by a user of the useful data (DE doc:

P19 and 23-25, or machine translation: page 4 paragraph 4 and page 5 paragraphs 1-3, etc). According to Barkowski's invention, a user defines a region of map data that he wishes to enable, and transmits his defined region (along with other data) to a remote server. In response, the remote server transmits a key to unlock/enable the defined region of map data. The region may be a geographical region such as northern Germany. In the machine translation, the term translated as "de-energising" is equivalent to the claimed term "enabling".

Barkowski does not disclose defining the area by the user by defining a center point and a radius of a circular region.

In the same field of endeavor, Person discloses a similar method for operating a vehicle navigation system including enabling the useful data for an area defined by the user by defining a center point and a radius of a circular region (fig 4, col 3: 44-51, col 7: 16- col 8: 12, etc).

It would have been obvious at the time of the applicant's invention to modify Barkowski to define the area by center point and radius, as taught by Person, in order to enable an area most likely to be used, rather than an area that corresponds to a political boundary, with predictable results.

Regarding claim 10, Barkowski further discloses that the enabling of useful data includes granting of a use authorization for an area defined by the user (DE: P19 and 23-25, or MT: page 4 paragraph 4 and page 5 paragraphs 1-3, etc) transmitted via a radio signal (DE doc: paragraph 17, or MT: page 4 paragraph 2, etc).

Barkowski does not disclose defining the area by the user by defining a center point and a radius of a circular region.

In the same field of endeavor, Person discloses a similar method for operating a vehicle navigation system including an area defined by the user by defining a center point and a radius of a circular region (fig 4, col 3: 44-51, col 7: 16- col 8: 12, etc).

It would have been obvious at the time of the applicant's invention to modify Barkowski to define the area by center point and radius, as taught by Person, in order to authorize an area most likely to be used, rather than an area that corresponds to a political boundary, with predictable results.

Regarding claim 12, Barkowski further discloses that the enabling takes place in a time-limited manner (DE: paragraph 22, or MT: page 3 paragraph 7, claim 13, etc). The area is enabled for only a certain period.

Regarding claim 13, Barkowski further discloses that the area defined by the user is not limited to any political boundary (DE: paragraph 23-24, MT: page 5 paragraphs 1-2, etc: multiple political regions can be enabled, therefore enabled area is not limited to any single political boundary).

See also Person (fig 4, col 3: 44-51, col 7: 16- col 8: 12, etc).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Chen whose telephone number is (571) 270-1330. The examiner can normally be reached Mondays through Fridays, between 10:00 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached at (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://www.uspto.gov/ebc>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Shelley Chen/
Patent Examiner
Art Unit 3661
October 21, 2011